

REMARKS

In response to the Office Action dated November 1, 2007, claims 1, 10, 13, 27, 36 and 37 have been amended. Claims 1-19, 21, 24-30, 32 and 35-37 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-19, 21, 23-30, 32 and 35-37 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, on page 5 of the November 1, 2007 Office Action, the Examiner alleged that "[N]owhere in the specification is disclosed or suggested that the advertiser submits the advertisement in any size and then is automatically resized to fit within available advertising locations on a page of the publication and automatically resizing at least of existing content or dynamic content to fit within available space on the page near the publication space then auctioning the resized candidate advertisements to advertisers." The Examiner continued to state that "Applicant's disclosure **does not teach or suggest that the ad is auctioned after it has been resized nor does it teach that the dynamic content is auctioned to content providers.** Applicant also **does not disclose the candidate advertisements represented be advertisers are in good credit standing.**"

The Applicant respectfully disagrees with the Examiner and submits that the original specification completely supports the rejected language and traverses this rejection based on the arguments below.

Specifically, the original specification clearly states on page 6 at lines 28-29 that "...the content information files and candidate advertising ***might be suitably resized in auctioning ads*** as described herein to further maximize advertising revenue." ***[emphasis added]***. In addition, the original specification explicitly states on page 6 at lines 31-32 that "***Re-sizing ads and content might done at any conveniently located step.***" ***[emphasis added]***. Hence, since the original specification unquestionably teaches that **re-sized advertisements are in auctioning advertisements and can be done at any step**, the claimed language of "auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers" is clearly supported.

Further, the Examiner incorrectly stated that the specification "**does not teach or suggest**" certain claimed features. For example, case law, such as **Stahelin v. Seher**,

24 USPQ2d, 1513 (B.P.A.I. 1992), clearly states that "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement...How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support." *Id.* At 1516 (citing In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (C.C.P.A 1971)) (emphasis in original).

As such, the Applicant submits that the original specification does not contain any reason to doubt the Figures or description for the claimed elements of "...auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers by receiving at least first and second respective offers..." because, as argued above, the original specification states that "...the content information files and candidate advertising might be suitably resized in auctioning ads..." and that "Re-sizing ads and content might done at any conveniently located step," which would enable one of ordinary skill in the art to make or use the invention without undue experimentation.

The Examiner's approach is contrary to well established case law and has no legal basis because the Examiner can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999). Namely, the Federal Circuit has clearly stated that patent applications should be written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

Therefore, the description in the specification provides enough enabling support for the claimed "auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers by receiving at least first

and second respective offers." As stated in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999), a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. Thus, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. § 112, first paragraph.

The Office Action rejected claims 10, 13, 27, 36 and 37 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.

The Applicant respectfully disagrees with the Examiner and submits that the claims are not indefinite and traverses this rejection based on the arguments below.

Specifically, the Applicants do not understand the Examiner's reasoning because the elements rejected are not mutually exclusive of each other. For instance, on page 4 at lines 4-13, the original specification states the "...actual location of the ad's placement in the publication – and therefore the value to a prospective advertiser - will vary according to a variety of factors, including, but not limited to the content information (files) that will comprise the rest of the publication at delivery time. **Advertising placement offers might also therefore include terms that specify an amount based upon placement location in the publication.** Similarly, an advertiser might require certain **minimum amounts for ads placed in certain areas or locations of the publication.** Advertising offers – **including both monetary and non-monetary terms**, both of which are considered herein and for claim construction to be offer "amounts" and/or offer "prices" – are evaluated at step 120." **[emphasis added]**. The overall offer can have several conditions and limitations, such as placement offers and minimums. Thus, the Applicant respectfully submits that the claims are not indefinite.

The Office Action rejected claims 1-9, 11, 13-19, 21, 24-30, 32 and 35-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hanson et al. (U.S. Patent No. 5,974,398) in view of Markowitz et al. (U.S. Patent No. 6,311,185). The Office Action rejected claims 10-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Markowitz et al. in view of Hanson et al.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant submits that the combined references are missing the features of the claims. For example, the combined cited references merely disclose modifying a web page by adding an advertisement (see Abstract, Summary, FIG. 3 and cols. 3 and 4 of Markowitz et al.) and an advertisement bidding system that allows advertisers to display their paid ads, which when viewed by a user, pays for a portion of the user's service or usage charge (see Abstract, FIGS. 13-15, col. 9, line 29 to col. 11, line 5 of Hanson).

In contrast, the Applicant's claimed invention includes using advertising placement offers in the first and second offers that include terms specifying an amount based upon specific placement location in the publication, using specified minimum amounts in the first and second offers for advertisements placed in predetermined areas or locations of the publication and using monetary and non-monetary terms in the first and second offers. These features clearly are not disclosed, taught or suggested in the combined cited references.

According to case law and the MPEP, all of the claimed elements of an Appellant's invention **must be considered**. (*In re Kotzab*, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143*). If **one** of the elements of the Appellant's invention is missing from or not taught in the cited references and the Appellant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP 2143.03*). The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Moreover, as argued in a previous amendment, the combined references are also missing the Applicant's claimed using heuristic data to determine if any of the candidate advertisements have already been sent to the subscriber and if another delivery of the same, related or similar advertisements are appropriate according to advertiser demands, expectations, payment and the subscriber's demographic data **and automatically resizing** the candidate advertisements and the dynamic content, **auctioning the resized candidate advertisements and the resized dynamic content** by receiving offers and placing on the page of the on-line publication candidate

advertisements corresponding to the greatest offer of the auction of the resized advertisements and content.

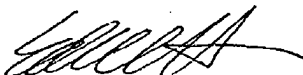
Thus, since the combined references are missing at least one feature of the Applicant's claimed invention, they cannot render the claims obvious. As such, a prima facie case of obviousness cannot be established, and hence, the rejections must be withdrawn. In *Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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